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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Graeme McKinnon et al.

Serial No.: 09/751,312

Filed: December 29, 2000

For: MODULAR TIMEMASKING
SEQUENCE PROGRAMMING FOR
IMAGING SYSTEM

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Group Art Unit: 2862

Examiner: Shrivastav, B.

Atty. Docket: GEMS:0011--1
15-NM-5910

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TECHNICAL CENTER 15-2003
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Assistant Commissioner
for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING 37 C.F.R. 1.8	
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:	
October 9, 2001 Date	 Ralph A. Graham

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

In the Official Action mailed September 10, 2001, the Examiner restricted examination of claims 30-95 in the above-referenced application. To respond to the restriction, Applicants elect to prosecute claims 30-39, 65-70, 90, and 93 of Group I. Reconsideration of the restriction is respectfully requested.

Applicants respectfully traverse the restriction. The present restriction is improper because the Examiner has not shown that the claimed inventions are independent or distinct and that a search and examination of the entire application could not be made without serious burden. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a)-§ 806.04(i), § 808.01(a), and § 808.02). MPEP § 803. Furthermore, if the search and examination of an

entire application can be made without serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. See MPEP § 803

In the Official Action, the Examiner stated that:

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. The species best illustrated by claims 30-39, 65-70, 90, and 93 to Group I as teaching a method and an apparatus for configuring a control sequence in an imaging system.
- II. The species best illustrated by claims 40-53, 71-80, 91, and 94 to Group II as teaching a method and an apparatus to enhance operation of a medical diagnostic system.
- III. The species best illustrated by claims 54-64, 81-89, 92, and 95 as teaching a method and apparatus to coordinate a plurality of activities of a diagnostic system.

The Examiner then stated that:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently no claim is deemed to be generic.

However, the Examiner's stated meaning of 35 U.S.C. § 121 is incorrect in an important regard. The statute specifically states that: If two or more independent and distinct inventions are claimed in one application, the Director *may* require the application to be restricted to one of the inventions. This is an important distinction over the Examiner's statement because the USPTO has established specific rules that an Examiner must follow before an application may be restricted. These rules require an

Examiner to do more than just say that independent and distinct inventions are claimed in an application before allowing the Examiner to restrict the application.

Specifically, under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. See MPEP §803. However, according to the MPEP, if the search and examination of an entire application can be made without serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. See MPEP §803. In the Official Action, the Examiner provided no evidence that the claimed inventions were independent or distinct. Furthermore, even where the related inventions are shown to be distinct under the criteria of MPEP §806.05(c)-§806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classified together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. MPEP § 808.02.

In the Official Action, the Examiner provided no evidence showing any of the above-listed reasons for restriction. No classifications were provided for any of the stated species of the claimed invention. No reasons, examples, or patents were provided to indicate why the inventions would have a separate status in the art or that there are different fields of search for any of the cited inventions. Where the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. MPEP §808.02. For all of these reasons, the restriction requirement is improper and the restriction requirement should be withdrawn.

Conclusion

In view of the above remarks set forth above, Applicants respectfully request that the restriction requirement be withdrawn. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: October 9, 2001



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